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10/675,515

09/30/2003

Jacqueline Evynne Breuninger Buskop

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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/675,515

**Applicant(s)**BUSKOP, JACQUELINE EVYNNE  
BREUNINGER**Examiner**

David C. Reese

**Art Unit**

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5, 7-9, and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-9 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2007 has been entered. Consequently, the following is the current listing of claims in the instant application:

### ***Status of Claims***

- Claims 2-4, 6, 10-12, and 14 were canceled.
- Claims 1, 5, 7-8, and 13 were amended.
- Claims 1, 5, 7-9, and 13 are pending.

### ***Claim Objections***

[1] Claim(s) 1 and 7 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 10/19/2007. Accordingly, the objection(s) to the claim(s) 1 and 7 have been withdrawn.

However, as amended:

Claims 1 and 8 are objected to the following informalities: It is stated in lines 8-10 of the claims that at least a first prong and a second prong engage at least two different edible food items. It is then stated further in the claims (lines 11-13) that the at least two different edible food items are partially penetrated (engaged) by each hook. Appropriate clarification as to which part of the hook and/or prong being attached to the at least two different edible food items

needs to be properly delineated in the instant claim as the terminology used is currently inconsistent.

***Claim Rejections - 35 USC § 112***

[2] Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The statements in the instant claims regarding that the automatic LED is “electrically insulated” as well as the advertising apparatus consisting of “a pair of earrings” is considered new matter. The disclosure of the instant application does not provide for an adequate description or basis for such subject matter in the claims. This is a new matter rejection.

***Claim Rejections - 35 USC § 103***

[3] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Claims 1, 5, and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Westmoland US-5,201,578, in view of Bradley, US-2,180,726, and in further view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Westmoland teaches of lighted jewelry (see Fig. 8) consisting of a pair of earrings (it is inherent in the art of jewelry for the disclosure of one earring to be worn as a pair), wherein each earring consists of:

a. at least one earring clip (10 in view of col. 2, line 10, “For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears,” as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;

b. at least one line (29) axially secured to the at least one earring clip (10),

d. an automatic LED (4) disposed on a lower portion of the front side [for lighting the item] (4; from col. 3, beginning with line 16, “Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”), wherein the automatic LED (4) is electrically insulated (it is inherent that the LED light itself is to some degree electrically insulated from the clip at the top of the earring provided by Westmoland; further, the leads 5 and 6 and inserted into the LED, 4, in a similar manner as shown in Fig. 6, thus satisfying the limitation of the LED being electrically insulated from the earring clip, 10, above) from the at least one earring clip (10), and wherein the automatic LED is a blinking LED light that can be actuated with a switch secured to the at least one earring clip (10) illuminating the item (Col. 4, 58-66; col. 5, lines 15-58, specifically, “The microchip may be designed to

provide a controlled pattern of flashing (blinking) to the lighting elements...” and further, “To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, “apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5.” Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192).

The difference between the claim and Westmoland is that Westmoland does not expressly state of a first and second hook axially secured to the at least one line; wherein the first hook and the second hook each have at least a first prong and a second prong respectively, for engaging at least two different edible food items, as well as each edible food item being at least partially penetrated by each hook. Westmoland does also not expressly state of removably securing to the at least one line at least two edible food items selected from a member of the group consisting of: a fruit, a vegetable, and combinations thereof. Bradley discloses of a jewelry device similar to that of Westmoland. In addition, Bradley further teaches of a first hook (17) and a second hook (17) axially secured (via 13) to the at least one line (10), wherein the first hook (17) is axially aligned with the hook (17); and wherein the first hook and the second hook each have at least a first prong (22) and a second prong (22), respectively, for engaging at least two items (12), with each item (12) being at least partially penetrated (col. 2, lines 53-55, “The flower, for example, or a portion thereof may be disposed between the piercing points 22”) by each hook (17) (as shown by Fig. 3). Bradley also discloses of securing to the at least two (line 43, “...may be used

to support edible items selected from a member of the group consisting of: a fruit, a vegetable (line 26, "real or artificial vegetables"), and combinations thereof. It would have been obvious to one of ordinary skill in the art, having the disclosures of Westmoland and Bradley before him at the time the invention was made, to modify the line (29) of Westmoland to include a first and second hook with respective prongs, said hooks/prongs penetrating various decorative/edible items as in Bradley. One would have been motivated to make such a combination because adding such hooks with prongs allows for the user to attach various decorative items for aesthetic purposes such as artificial flowers, artificial vegetables and the like, so that the appearance, color and style of the articles may be varied as desired to match or contrast with the ensemble of the wearer, as taught by Bradley (col. 1, lines 9-16).

Bradley fails to expressly disclose of at least two edible items being attached to said hook/prong. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add two instead of one edible item such a real vegetable (as taught by Bradley), since it has been held that mere duplication of the essential working parts of a device involves only routine skilled the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. And further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Re: Claim 5, Westmoland in view of Bradley teach wherein the first and second hooks (17) are between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in

the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re: Claim 7, Bradley discloses wherein the at least one edible item is selected from a member of the group consisting of: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruits, other fruits, other vegetables (line 26, "real or artificial vegetables"), and combinations thereof.

[5] Claims 8-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westmoland US-5,201,578, in view of Bradley, US-2,180,726, in view of Johnson, US-6,619,816, and in even further view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.



As for Claim 8, Westmoland teaches of lighted jewelry (see Fig. 8) consisting of a pair of earrings (it is inherent in the art of jewelry for the disclosure of one earring to be worn as a pair), wherein each earring consists of:

a. at least one earring clip (10 in view of col. 2, line 10, “For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears,” as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;

b. at least one line (29) axially secured to the at least one earring clip (10),

d. an automatic LED (4) disposed on a lower portion of the front side [for lighting the item] (4; from col. 3, beginning with line 16, “Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”), wherein the automatic LED (4) is electrically insulated (it is inherent that the LED light itself is to some degree electrically insulated from the clip at the top of the earring provided by Westmoland; further, the leads 5 and 6 and inserted into the LED, 4, in a similar manner as shown in Fig. 6, thus satisfying the limitation of the LED being electrically insulated from the earring clip, 10, above) from the at least one earring clip (10), and wherein the automatic LED is a blinking LED light that can be actuated with a switch secured to the at least one earring clip (10) illuminating the item (Col. 4, 58-66; col. 5, lines 15-58, specifically, “The microchip may be designed to provide a controlled pattern of flashing (blinking) to the lighting elements...” and further, “To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, “apertures 24 are located and sized to accept contact pins 22 extending from

microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5.” Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192).

The difference between the claim and Westmoland is that Westmoland does not expressly state of a first and second hook axially secured to the at least one line; wherein the first hook and the second hook each have at least a first prong and a second prong respectively, for engaging at least two different edible food items, as well as each edible food item being at least partially penetrated by each hook. Westmoland does also not expressly state of removably securing to the at least one line at least two different candy items. Bradley discloses of a jewelry device similar to that of Westmoland. In addition, Bradley further teaches of a first hook (17) and a second hook (17) axially secured (via 13) to the at least one line (10), wherein the first hook (17) is axially aligned with the hook (17); and wherein the first hook and the second hook each have at least a first prong (22) and a second prong (22), respectively, for engaging at least two items (12), with each item (12) being at least partially penetrated (col. 2, lines 53-55, “The flower, for example, or a portion thereof may be disposed between the piercing points 22”) by each hook (17) (as shown by Fig. 3). It would have been obvious to one of ordinary skill in the art, having the disclosures of Westmoland and Bradley before him at the time the invention was made, to modify the line (29) of Westmoland to include a first and second hook with respective prongs, said hooks/prongs penetrating various decorative/edible items as in Bradley. One would have been motivated to make such a combination because adding such hooks with prongs allows for

the user to attach various decorative items for aesthetic purposes such as artificial flowers, artificial vegetables and the like, so that the appearance, color and style of the articles may be varied as desired to match or contrast with the ensemble of the wearer, as taught by Bradley (col. 1, lines 9-16).

Though Bradley states of attaching real vegetables or in fact any other article now commonly used for the ornamentation of novelty jewelry and accessories, he fails to expressly disclose said items attached to said hook/prong as candy. Johnson discloses an illuminated novelty confection item similar to that of Westmoland in view of Bradley. In addition, Johnson further teaches of at least one edible food item (col. 2, lines 18-20, "...includes a light device, a light transmission element attached to the light device, and an edible confection attached...") removably secured to said item, with said edible food item (12 of Johnson) being selected from the group of a fruit, vegetable, and/or combinations thereof (col. 2, lines 59-64, "The confection does not necessarily have to be limited to candies, and could include virtually anything edible..."). It would have been obvious to one of ordinary skill in the art, having the disclosures of Westmoland in view of Bradley before him at the time the invention was made, to modify the decorative item attached to the illuminated nonpiercing earring of Westmoland in view of Bradley to include at least one candy item as in Johnson. One would have been motivated to make such a combination because having edible items secured onto an item thereby creating a illuminated novelty confection enhances further the amusement (illuminating the confection) and commercial viability of such products (col. 2, lines 2-3); and from col. 3, lines 3-13, "From a usage or demographic perspective, there are several possibilities including children candies,

specialty concession, novelties, premium, advertising and contest marketing...” as taught by Johnson.

Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add two instead of one edible item such as candy (as taught by Johnson), since it has been held that mere duplication of the essential working parts of a device involves only routine skilled the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. And further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Re: Claim 9, Johnson discloses wherein the at least one chewy item is selected from a member of the group consisting of: soft licorice, soft raspberries, juicy fruits, and combinations thereof ((col. 2, lines 59-64, “The confection does not necessarily have to be limited to candies, and could include virtually anything edible...”).

Re: Claim 13, Westmoland in view of Bradley teach wherein the first and second hooks (17) are between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232

(1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

***Response to Arguments***

[6] Applicant's amendments and arguments filed 10/19/2007 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. Beginning with applicant's arguments concerning the prior art of Westmoland, applicant states that Westmoland does not teach of an invention that blinks. The examiner disagrees, as Westmoland does indeed disclose of an invention that blinks since as stated by Westmoland, "The microchip may be designed to provide a controlled pattern of flashing (blinking) to the lighting elements..." The applicant continues by discussing the feature of the LED light being electrically insulated from the earring clip. The examiner would like to point out, however, that the explanation and pertinence regarding the electrically insulated LED light as stated in paragraph two on page 8 of the remarks is not even found in the original disclosure as provided by the applicant. Further, as stated above by the examiner, it is inherent that the LED light provided by Westmoland itself is to some degree electrically insulated from the clip at the top of the earring; since further, the leads 5 and 6 and inserted into the LED, 4, in a similar manner as shown in Fig. 6, thus satisfying the limitation of the LED being electrically insulated from the earring clip, 10. Excluding the fact that the LED light is not properly described in the specification by applicant, the LED light being "electrically insulated" from the earring is given the reasonable interpretation possible and further, applicant misinterprets the principle that claims are interpreted in the light of the

specification. Although these elements are found as examples of embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Lastly, the applicant with regard to Westmoland states that Westmoland does not teach use of blinking LEDs for the purpose of simultaneously illuminating and attracting attention toward two different objects attached to an earring. As stated above, Westmoland does indeed disclose of a blinking LED, the purpose of which does not have to be the same, or described as such as long as the prior art of Westmoland is indeed capable of performing said function as it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Arguments regarding the prior art of Furlonge are considered moot to said new grounds of rejection as provided by Bradley above.

Lastly, the applicant argues the examiner's interpretation and application of the prior art of Johnson. In the remarks, the applicant however seems to solely address other features of the claims that Johnson does not necessarily address or teach such as having one or more hooks, etc, such as that found in paragraph two on page 11 and paragraph two from page 12 of applicant's remarks. In response, to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

And further, it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

***Conclusion***

**[7] THIS ACTION IS NON-FINAL**

**[8]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30-6:00Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached at 571-272-7075(571) 272-7069. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./  
Examiner, Art Unit 3677

/Robert J. Sandy/  
Primary Examiner, Art Unit 3677